

I. AMENDMENT

Please make the following amendments:

In the Claims

19. A pocket for suspending an embellishment on a garment, said pocket consisting of an outside panel comprising:

a substantially unstitched top edge;

a bottom edge;

a left edge; and

a right edge;

wherein said pocket comprises a sheer fabric and wherein said left edge and said right edge are stitched to a back panel so that said outside panel forms an opening to receive the item to be suspended, and wherein said bottom edge may be unstitched, substantially unstitched, partially stitched or totally stitched, and wherein said pocket is virtually invisible.

27. A garment having one or more sheer pockets for suspending an embellishment, said garment comprising:

at least one layer of fabric;

at least one sheer pocket attached to a layer of said fabric, wherein said pocket is virtually invisible; and

at least one embellishment suspended in said pocket;

wherein said pocket consists of an outside panel comprising:

a substantially unstitched top edge;

a bottom edge;

a left edge; and

a right edge;

B² wherein said left edge and said right edge are stitched to said fabric so that said outside panel forms an opening to receive the embellishment to be suspended, and wherein said bottom edge may be unstitched, substantially unstitched, partially stitched or totally stitched.

B³ 30. The garment of claim 29, wherein said outside panel and said fabric are of different materials.

RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-18 were issued in U.S. Patent No. 6,131,205. Claims 19-31 were added in the Preliminary Amendment filed with the request for reissue on August 6, 2001. Thus, claims 1-31 were pending at the time of the present Action. Claims 19, 27 and 30 are amended herein to clarify the subject matter of the claims. No claims are added or cancelled herein. Thus, claims 1-31 remain pending. A marked up copy of the amended claims is attached hereto as Appendix A.

B. A Corrected Reissue Oath/Declaration Is Included Herewith

The Action first points out that the reissue oath/declaration filed with the application was defective in that it identified the inventor as a joint inventor but failed to include signatures from any additional inventors. Applicant submits herewith a revised oath/declaration stating that she is the sole inventor of the invention claimed.

The corrected oath/declaration also appoints Ms. Teresa J. Schultz as Applicant's agent for communication with the Office. Please forward any reply to this communication, and any future communications, to the address below:

Teresa J. Schultz, Esq.
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**C. Applicant Has Incorporated the Changes
Made by the Certificate of Correction**

The Action next asserts that Applicant has failed to incorporate the changes made by the Certificate of Correction, referring to MPEP § 1411.01. Section 1411.01 states that changes made to the patent by Certificate of Correction should be incorporated without the use of underlining or brackets. Applicant acknowledges that the Preliminary Amendment incorrectly requested amendment of the claims to incorporate the Certificate of Correction changes. The currently pending claims, as amended by Certificate of Correction and as amended herein, are set forth in Appendix B without underlining or brackets.

D. Claim 30 is Definite

The Action rejects claim 30 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the Action asserts that claim 30 is confusing as the outside panel is understood to comprise the fabric and therefore could not be different from the fabric. Applicant respectfully traverses.

Claim 30 has been amended herein to clarify its dependency. It now depends from claim 29, which depends from claim 28, which depends from claim 27. Claim 27 makes it clear that the pocket on the claimed garment consists of an outside panel, and the garment comprises at

least one layer of fabric with at least one sheer or clear pocket attached to a layer of said fabric.

As used in claim 27, the term fabric is always used to describe the garment while the pocket, consisting of an outside panel, is a separate entity, though attached to the garment. The fabric of the garment serves as the “back panel” of the pocket. The specification clearly describes that the pocket and the garment may be of the same, or different, fabric. In particular, the specification states as follows:

Typically, the pocket of the invention will be made of sheer fabric. In preferred embodiments, the pocket of the invention will be made of tulle or organza. It will be understood that the “back panel” to which the pocket is stitched will generally be of the same sheer fabric as the pocket. Although it is certainly within the scope of the invention to use different sheer fabrics for the pocket and the back panel, depending upon the desired application.

Col. 3, lines 9-16 (emphasis added).

It is well established that the claims must be read in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Watson*, 517 F.2d 465, 477, 186 U.S.P.Q. 11, 20 (Cust. & Pat. App. 1975); *Penda Corp. v. U.S.*, 29 Fed. Cl. 533, 554 (Fed. Cl., 1993). The Federal Circuit has repeatedly stated that “a claim is sufficiently definite for purposes of the second paragraph of section 112 if one of ordinary skill in the art would understand what is claimed, when the claim is read in light of the Specification.” *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991); *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 786 (Fed. Cir. 1988). The *Telectronics* court further stated that “[i]f the claims, read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.” *Telectronics*, 857 F.2d at 786; *see also Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947, 107 S. Ct. 1606, 94 L.Ed.2d 792

(1987). Thus, Applicant submits that those skilled in the art would be able to determine from the disclosure, that the pocket and the garment may be made from the same fabric or from different fabrics.

For the foregoing reasons, Applicant respectfully requests that the definiteness rejection be withdrawn.

E. The Claims Are Not Anticipated

The Action rejects claims 19, 22, 24-27, 30 and 31 as being anticipated by Hayes. Hayes is said to show a pocket of sheer or net material stitched to a backing on left, right and bottom edges. Applicant respectfully traverses.

The crux of the present invention is that the claimed pocket is virtually invisible on the garment so that the embellishments suspended therein appear to be “floating” on the garment. The form of the pocket also allows for easy deposit and removal of the embellishments so that live flowers or keepsake items may be suspended on a garment. The shape of the pocket, the size of the pocket and the location of the pocket are relatively unimportant – virtually any shape or size pocket is within the scope of the invention.

There is no teaching or suggestion within Hayes that the pocket described therein should be, or could be, virtually invisible. In fact, the description and drawings presented in Hayes make it clear that the pocket described therein is quite visible. The purpose of Hayes’ pocket is to conveniently hold an extra tennis ball on the side of a tennis player’s garment for ease of access when necessary. It serves a useful and practical purpose. On the other hand, the purpose of the pocket of the present invention is to hold an embellishment so that it appears to be “floating” on a garment. It serves an aesthetic purpose. Without a teaching or suggestion within